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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184986
Party	Defendant Brazil Cigars & Tobacco, LLC
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Submission	Motion to Suspend for Civil Action
Filer's Name	Gustavo Sardina
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Date	08/20/2009
Attachments	supplemental motion to suspend.pdf ( 2 pages )(13314 bytes ) exhibit a.pdf ( 1 page )(5601 bytes ) (1) Complaint.pdf ( 25 pages )(1230176 bytes ) (7) ANSWER and Affirmative Defenses to Complaint & COUNTERCLAIM.pdf ( 22 pages )(58783 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In The Matter of Trademark Application No. 76/651,986**

MENENDEZ AMERINO & CIA LTDA,	)	
	)	
Opposer,	)	
	)	
vs.	)	Opposition No. 91184986
	)	
BRAZIL CIGARS & TOBACCO, LLC,	)	
	)	
Applicant.	)	
_____	)	

**SUPPLEMENT TO MOTION TO SUSPEND  
PENDING DISPOSITION OF DISTRICT COURT ACTION**

Applicant, Brazil Cigars & Tobacco, LLC, (hereinafter “Applicant” or “Brazil Cigars”), by and through undersigned counsel, and pursuant to Trademark Rule 2.117(a), hereby files this Supplement to its Motion to Suspend Pending Disposition of District Court Action as follows:

On August 18, 2009 the Applicant filed its First Motion to Suspend Pending Disposition of District Court Action. (D.E. 14). However, such Motion did not include a copy of the pleadings in the civil action. As such, Applicant hereby files this supplement to the Motion including Composite Exhibit A, attached hereto with the operative pleadings to the Federal District Court Action upon which the Motion to Suspend is based.

Dated: August 20, 2009

Respectfully submitted,  
ROTHSTEIN ROSENFELDT ADLER

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the foregoing was served on

Lawrence E. Abelman, Esq.  
Julie B. Selyer, Esq.  
ABELMAN FRAYNE & SCHWAB  
666 Third Avenue  
New York, New York 10017

by electronic mail as well as by United States FIRST CLASS U.S. MAIL, postage pre-paid  
this 20<sup>th</sup> day of August, 2009.

By: s/GUSTAVO SARDIÑA  
Frank Herrera, Esq.  
Florida Bar No. 494801  
Gustavo Sardiña  
Florida Bar No. 31162

**CERTIFICATE OF ELECTRONIC FILING USING ETTSA**

I HEREBY CERTIFY that on August 20, 2009 a true and correct copy of the foregoing was  
filed electronically using the TTAB's ETTSA filing system.

By: s/GUSTAVO SARDIÑA  
Frank Herrera, Esq.  
Florida Bar No. 494801  
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# EXHIBIT A

FILED by ELECTRONIC	Page 1 of 25 MB	D.C.
<b>May 1, 2009</b>		
STEVEN M. LARIMORE CLERK U.S. DIST. CT. S.D. OF FLA. - MIAMI		

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA**

Case No. \_\_\_\_\_

**09-21185-Civ-HOEVELER/GARBER**

MENENDEZ AMERINO & CIA. LTDA.,	)	
a Brazil corporation,	)	
	)	
Plaintiff,	)	
	)	
v.	)	
	)	
BRAZIL CIGARS & TOBACCO LLC,	)	
a Delaware corporation,	)	
	)	
Defendant.	)	
	)	
_____	)	

**COMPLAINT FOR:**

- 1. False Designation of Origin and  
Trade Dress Infringement  
[15 USC § 1125(a)];**
- 2. Trademark Infringement  
[15 USC § 1125(a)];**
- 3. Trademark Dilution  
[15 USC § 1125(c)];**
- 4. Cybersquatting  
[15 USC § 1125(d)];**
- 5. Breach of Contract;**
- 6. Defamation—Slander;**
- 7. Defamation—Libel;**
- 8. Unfair Competition.**

**JURY TRIAL DEMANDED.**

Plaintiff Menendez Amerino & Cia Ltda (“Plaintiff” or “Menendez”) for its Complaint alleges as follows:

**Nature of the Action**

1. This is an action for willful violations of Menendez’s intellectual property rights (including trademark infringement, trade dress infringement, trademark dilution, and

cybersquatting); for breach of contract; and for defamation; all arising out of the production, importation, distribution, sale, and offer for sale by Defendant Brazil Cigars & Tobacco LLC (“Defendant” or “BCT”) of blatant counterfeits of Menendez’s trademarked, proprietary DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars; Defendant’s attempt to register those same common law trademarks under Defendant’s name and without Menendez’s permission; and Defendant’s defamatory remarks regarding Menendez’s proprietary and authentic cigars.

### **Jurisdiction and Venue**

2. This action arises under the trademark laws of the United States, specifically the Lanham Act, 15 U.S.C. § 1051 *et seq.*

3. This Court therefore has subject matter jurisdiction over this action as a federal question pursuant to 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a). The Court also has supplemental jurisdiction over the defamation and breach of contract claims pursuant to 28 U.S.C. § 1367, and pendent jurisdiction of those claims under 28 U.S.C. § 1338(b). As the parties are completely diverse in citizenship and the amount in controversy is over \$75,000, diversity jurisdiction also exists under 28 U.S.C. § 1332.

4. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c), and 28 U.S.C. § 1400(a), in that Defendant may be found in this judicial district through, *inter alia*, doing business in this judicial district and being subject to personal jurisdiction therein; and a substantial part of the events and omissions giving rise to the claim occurred in this judicial district.

### **The Parties**

5. Plaintiff Menendez Amerino & Cia Ltda (“Plaintiff” or “Menendez”) is a Brazilian corporation at all times relevant hereto organized and in good standing under the laws of Brazil, and having its principal place of business at Rua do Corredor D, 714 – Centro, Salvador, Bahia, Brazil.

6. Menendez was formed in 1977 by brothers Félix and Benjamin Menendez, sons of famed cigar maker Alonso Menendez, and their partner and brother-in-law Mário Amerino Portugal. Menendez has engaged in the business of manufacturing, marketing, and selling cigars and cigarillos on a worldwide basis, including the United States. Menendez's principal customers are cigar distributors, importers, retailers, and end-user retail consumers.

7. Defendant Brazil Cigars & Tobacco LLC ("BCT") is, on information and belief, a Delaware corporation with its principal place of business at 4364 SW 74 Avenue, Miami, Florida 33155. On information and belief, BCT is a limited liability company that imports and distributes Brazilian cigars throughout the United States, including within this judicial district.

8. On information and belief, this Court has personal jurisdiction over the Defendant by virtue of Defendant's residence in this judicial district, Defendant's conducting of business in this judicial district including merchandise sales, and Defendant's other contacts and transaction of business in this judicial district and delivery into the stream of commerce in this district of products accused herein of violating Menendez's intellectual property rights. Defendant has purposefully availed itself of the privileges and benefits of doing business within this district.

### **The Contract**

9. On March 11, 2005, after extensive negotiations, a Distribution Agreement ("Agreement") was executed between Menendez and Defendant, which established Defendant as the distributor of certain Menendez products, mainly cigars and cigarillos, in the United States, Canada, and Thailand. A true and correct copy of the Agreement is attached hereto as Exhibit A and incorporated herein by reference.

10. Menendez has fully performed all covenants and conditions of the Agreement.

11. Schedule 2 of the Agreement allowed Defendant to register Menendez's trademarks if and only if Defendant did so under Menendez's name at Menendez's cost, and could only register the trademarks while the Agreement was active. Menendez did not permit or consent to registration of Menendez's trademarks under any other terms or circumstances.

12. On June 17, 2005, Dana Sheldon, managing member of Defendant BCT, emailed Menendez asking for a letter stating that Menendez's previous U.S. distributor did not have trademark or patent rights to Menendez's products, and a letter authorizing Defendant to apply to register Menendez's trademarks with the United States Patent and Trademark Office ("USPTO"), without specifying under whose name. A true and correct copy of this email is attached hereto as Exhibit B and incorporated herein by reference.

13. On June 28, 2005, Menendez hand-delivered to Defendant's lawyer a letter that authorized Defendant to apply to register Menendez's marks with the USPTO, clarifying again that it had to be under Menendez's name, on behalf of Menendez. A true and correct copy of this letter is attached hereto as Exhibit C and incorporated herein by reference.

14. On November 16, 2007, Defendant wrote Menendez a letter which stated, among other things, that Defendant had applied to register Menendez's trademarks with the USPTO under Defendant's own name. A true and correct copy of this letter is attached hereto as Exhibit D and incorporated herein by reference.

15. On January 7, 2008, Menendez mailed a letter notifying Defendant that the Agreement was terminated pursuant to Clause 11.1(e), as Defendant had breached (a) Clause 6 of the Agreement by consistently delaying payments for merchandise received; (b) Clause 7.2.1 of the Agreement when Defendant refused to adopt a proposal to improve Defendant's personnel structure to meet U.S. market demands; (c) Clause 9.5 of the Agreement when Defendant failed to meet minimum order goals; and (d) Schedule 2 of the Agreement when Defendant applied to the USPTO to register Menendez's trademarks under Defendant's own name. A true and correct copy of this letter is attached hereto as Exhibit E and incorporated herein by reference.

16. On January 21, 2008, Defendant wrote Menendez, stating that Defendant refused to recognize the termination. A true and correct copy of this letter is attached hereto as Exhibit F and incorporated herein by reference. Defendant has since intentionally infringed upon Menendez's intellectual property rights, and defamed Menendez.



17. On April 10, 2008, Menendez requested extensions from the Trademark Trial and Appeal Board (“TTAB”) to file Oppositions against Defendant’s applications to register Menendez’s marks with the USPTO, which the TTAB granted. On July 2, 2008, Menendez filed its Oppositions with the TTAB (Oppositions #91184986 and #91184987). The proceedings are currently suspended, pending the outcome of this case.

**Menendez’s Intellectual Property Rights at Issue**

18. By virtue of Menendez’s extensive development, sales, and marketing activities regarding cigar products, Menendez has acquired substantial and valuable intellectual property rights including common law trademark rights to DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™, identifying trade dress, and other source identifiers. These intellectual property rights are of incalculable value to Menendez’s business, including Menendez’s ability to maintain goodwill with respect to its product lines and customers. Menendez’s careful maintenance and protection of its intellectual property rights is an important factor in the success of its business over the past thirty-two (32) years. The DONA FLOR™ and ALONSO MENENDEZ™ marks have been duly registered with the Brazilian patent and trademark office, Instituto Nacional da Propriedade Industrial (“INPI”), for over 20 years; registration of the newer AQUARIUS™ mark has been pending with INPI since 2006.

19. Menendez’s marketing efforts regarding the DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ trademarks in the United States have included, but are not limited to, printing and distributing promotional and marketing materials; interviewing with the media in important cigar industry trade journals, as well as mainstream media outlets such as the *New York Times*; sending representatives to participate in commercial fairs and expositions; and providing samples of its cigars and cigarillos.

20. Menendez’s unique blend of *Mata Fina* and *Mata Norte* tobacco grown in the northern part of the Recôncavo, a unique region of Brazil; its historical techniques and unique historical background; its marketing efforts; and its strong quality control for its proprietary

DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars. have earned Menendez a strong reputation, loyal clientele, and goodwill in the market.

**Trademark Protection for Menendez's DONA FLOR™, ALONSO MENENDEZ™, and  
AQUARIUS™ Cigars**

21. Menendez created the DONA FLOR™ (“Lady Flower”) series of cigars. Attached hereto collectively as Exhibit G and incorporated herein by reference are true copies of color photographs of some of Menendez’s DONA FLOR™ cigars. DONA FLOR™ has been used as a trademark to identify cigars continuously since at least as early as 1987, and at least as early as 2001 within this judicial district, and is a “famous mark” within the meaning of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c). Menendez has sold and promoted its DONA FLOR™ line of cigars through the various established channels of trade, including through importers and distributors.

22. Menendez prizes quality over quantity, as its DONA FLOR™ cigars are premium cigars carefully hand-crafted from only the best *Mata Fina* and *Mata Norte* leaves, grown by Menendez itself. DONA FLOR™ cigars burn more smoothly and with a more aromatic character than many other cigars, which has made DONA FLOR™ cigars extremely coveted.

23. The DONA FLOR™ cigar line was named after the title character of *Dona Flor e Seus Dois Maridos* (“Dona Flor and Her Two Husbands”), a book (and later a movie) written by Jorge Amado, close friend of Menendez’s co-founder and owner, Mário Amerino Portugal. Due at least in part to this interesting and unique background, as well as to Menendez’s marketing efforts and the quality of the cigars, cigar aficionados have long associated the DONA FLOR™ mark with Menendez.

24. The DONA FLOR™ cigars have met with acclaim, leading to a feature article (“The Cigar from Brazil”) by Victoria Shorr in the September/October 2005 issue of *Cigar Aficionado* magazine, documenting the history of the Menendez family and company. A true copy of an internet print-out of this article is attached hereto as Exhibit H and incorporated herein by reference.

25. Further acclaim for the DONA FLOR™ cigars includes: (i) The DONA FLOR™ Robusto scored an 8.7 in the Fall 2005 issue of *Smoke* magazine and an 89 rating in the December 2007 issue of *Cigar Aficionado* magazine; (ii) the DONA FLOR™ Double Corona was the Cigar of the Week in June 2006 on the *Cigar Aficionado* website and scored an 88 rating in the June 2006 issue of *Cigar Aficionado* magazine; (iii) the DONA FLOR™ Reserva Especial Ltd. Series Double Corona scored a 9.0 in the Spring 2007 issue of *Smoke* magazine; (iv) the DONA FLOR™ Seleção Robusto scored 92 points in the December 2007 *Cigar Aficionado* magazine; (v) the DONA FLOR™ 6x60 scored an 8.8 in the Spring 2008 issue of *Smoke* magazine; and (vi) the January 2006 issue of *Cigar Insider* rated the DONA FLOR™ Corona, Petit Corona, Churchill, and Pirâmide cigars 88, 88, 87, and 85, respectively.

26. Menendez has also created the ALONSO MENENDEZ™ cigars. Attached hereto collectively as Exhibit I and incorporated herein by reference are true copies of color photographs of Menendez's ALONSO MENENDEZ™ cigars. ALONSO MENENDEZ™ has been used as a trademark to identify cigars continuously since at least as early as 1980, and at least as early as 2005 within this judicial district (it was first used in this judicial district in 1980, but not continuously until 2005), and is a "famous mark" within the meaning of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c). Menendez has sold and promoted its ALONSO MENENDEZ™ line of cigars through the various established channels of trade, including through importers and distributors.

27. The ALONSO MENENDEZ™ cigar line was named after Menendez co-founder and co-owner Félix Menendez's father, Alonso Menendez. Alonso Menendez is one of the most famous cigar makers of all time, earning his recognition through his creation of the Montecristo brand and his ownership of the H. Upmann factory in Cuba before the Castro revolution forced him and his family to relocate. Due in part to this interesting and unique background, as well as Menendez's marketing efforts and the quality of the cigars, cigar aficionados have long associated the ALONSO MENENDEZ™ mark with Plaintiff Menendez.

28. The ALONSO MENENDEZ™ cigars have met with acclaim. For example, the November 2006 issue of *Cigar Insider* gave the ALONSO MENENDEZ™ Robusto, Especiales No.1, No. 10, and No. 20 cigars ratings of 89, 86, 86, and 84, respectively, describing the line, “The Alonso Menendez line is a Brazilian puro—uncommon in the cigar world. One of the cigar’s defining characteristics is its dark, rustic Mata Fina wrapper. The brand is named after famed Cuban cigar man Alonso Menendez.”

29. Menendez also created the AQUARIUS™ line of cigars. Attached hereto collectively as Exhibit J and incorporated herein by reference are true copies of color photographs of Menendez’s AQUARIUS™ cigars. AQUARIUS™ has been used continuously as a trademark to identify cigars since at least as early as 2003 worldwide, and at least as early as 2005 within this judicial district (it was first used in this judicial district in 2003, but not continuously until 2005), and is a “famous mark” within the meaning of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c). Menendez has sold and promoted its AQUARIUS™ brand of cigars through the various established channels of trade, including through importers and distributors.

30. The AQUARIUS™ cigars are made from a quality, accurate fermentation process, producing a smooth smoke, which is especially appreciated for beginner smokers who prefer mild cigars.

31. As Menendez’s prior-established lines of DONA FLOR™ and ALONSO MENENDEZ™ cigars were highly regarded, its AQUARIUS™ line was highly anticipated. Although the AQUARIUS™ cigars were not sold in the U.S. until 2003, *Smokeshop* magazine anticipated their release in as early as their October/November 2000 issue. The *New York Times* also interviewed Félix Menendez regarding the Aquarius cigars in its January 26, 2003 issue, resulting in an article, “Coming Soon to the U.S.: Cuban Cigars Made in Brazil.” Attached hereto collectively as Exhibit K and incorporated herein by reference are true copies of these two articles anticipating the release of the AQUARIUS™ cigars. Due to this anticipation, and along

with Menendez's marketing efforts and the quality of the cigars, cigar aficionados have associated the AQUARIUS™ mark with Menendez.

32. In 2007, Menendez's combined revenue for all of the above cigars exceeded \$320,000 in the U.S. alone. In 2008, that figure increased to over \$490,000. These figures are significant because Menendez is a custom cigar maker, not a mass producer.

**Trade Dress Protection for Menendez's DONA FLOR™, ALONSO MENENDEZ™, and  
AQUARIUS™ Cigars**

33. Menendez has promoted and sold the trademarked DONA FLOR™ cigar line in the United States and in this judicial district as early as 2001.

34. Most, if not all, cigars look similar in shape, for functional reasons, and are therefore distinguished at first sight by distinctive labels and packaging. The distinctive design to the DONA FLOR™ trade dress includes, but is not limited to, (a) an individual cigar logo label located on the top half of the cigar, with a portrait featuring the side profile of a female character (Dona Flor) smelling a red flower, and a bottom banner bearing the DONA FLOR™ mark; (b) a packaging logo with the elements described in (a), but with the addition of three coins and one coat of arms to each side of the portrait; (c) painted wooden boxes for the cigars containing the packaging logo on the outside and inside of the lid, with the words "Brazilian Hand Made Premium Cigars" under the logo, tiles along the edges, and the name of the cigar on the sides; (d) carton boxes containing the packaging logo, with tiles along the top and bottom and descriptive text; (e) tin cans for cigarillos containing the packaging logo, with a light background for the "Original," a dark, vertical-striped background for the "Pipe," and a snow-capped mountain background for "Ice."

35. These arbitrary and nonfunctional design elements, among others, constitute Menendez's proprietary trade dress in and operate as source identifiers for Menendez's DONA FLOR™ cigars.

36. Menendez's proprietary trade dress in the DONA FLOR™ cigars as described above is inherently distinctive.

37. Menendez's marketing and sales activities have resulted in the acquisition of further distinctiveness of Menendez's proprietary trade dress in the DONA FLOR™ cigars, thereby creating a strong secondary meaning in the minds of the consuming public as identifying Menendez's products.

38. Menendez has promoted and sold the trademarked ALONSO MENENDEZ™ cigar line in the United States and in this judicial district as early as 2005.

39. The distinctive design to the ALONSO MENENDEZ™ trade dress includes, but is not limited to, (a) a logo label located on the top half of the cigar, with "ALONSO" in small capitalized letters on the first line, "MENENDEZ" in small capitalized letters on the second line, both lines centered, plus stylized flower petals reminiscent of art deco patterns above and below the text; (b) wooden boxes for the cigars containing the logo on the outside and inside of the lid, and the name of the cigar on the sides; and (c) carton boxes containing the logo, with tiles along the top and bottom and descriptive text.

40. These arbitrary and nonfunctional design elements, among others, constitute Menendez's proprietary trade dress in and operate as source identifiers for Menendez's ALONSO MENENDEZ™ cigars.

41. Menendez's proprietary trade dress in the ALONSO MENENDEZ™ cigars as described above is inherently distinctive.

42. Menendez's marketing and sales activities have resulted in the acquisition of further distinctiveness of Menendez's proprietary trade dress in the ALONSO MENENDEZ™ cigars, thereby creating a strong secondary meaning in the minds of the consuming public as identifying Menendez's products.

43. Menendez has promoted and sold the trademarked AQUARIUS™ cigar line in the United States and in this judicial district as early as 2005.

44. The distinctive design to the AQUARIUS™ trade dress includes, but is not limited to, (a) a logo label located on the top half of the cigar, with an oval border containing the word "AQUARIUS" in all capitalized letters on the top and "CIGARS" in all capitalized but

smaller letters on the bottom; a rectangle on the left side of the border that reads “SEC” and a rectangle on the right side of the border that reads “XXI”; a portrait in the center containing a woman wearing a head wrap, tilting her head to the right; and a banner towards the bottom; (b) a logo containing the word “AquariuS” in italics, with the “S” capitalized and the top of the letter aligned with the top of the lowercased letters; (c) wooden boxes for the cigars containing the logo described in (b) on the outside and inside of the lid and on the sides of the box; and (d) carton boxes containing the logo described in (b), with a light border around the narrow sides.

45. These arbitrary and nonfunctional design elements, among others, constitute Menendez’s proprietary trade dress in and operate as source identifiers for Menendez’s AQUARIUS™ cigars.

46. Menendez’s proprietary trade dress in the AQUARIUS™ cigars as described above is inherently distinctive.

47. Menendez’s marketing and sales activities have resulted in the acquisition of further distinctiveness of Menendez’s proprietary trade dress in the AQUARIUS™ cigars, thereby creating a strong secondary meaning in the minds of the consuming public as identifying Menendez’s products.

#### **Acts of Infringement by Defendants**

48. Defendant has intentionally infringed Menendez’s intellectual property rights through Defendant’s sale and offer for sale of blatant counterfeits, or infringing copies, of Menendez’s proprietary DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars after the Agreement was terminated. Attached hereto collectively as Exhibit L and incorporated herein by reference are true copies of color photographs of sample infringing cigars and their packaging.

49. Defendants have intentionally infringed the above intellectual property rights of Menendez in order to misappropriate and benefit from the goodwill obtained by Menendez in the United States cigar market through Menendez’s efforts to convey its fascinating heritage, its



unique blend of *Mata Fina* and *Mata Norte* tobacco grown in the northern part of the Brazilian Recôncavo, its historical techniques, and its strong quality control.

50. Specifically, the accused cigars use the same trade dress as Menendez's proprietary cigars, and mirror the arbitrary, original design elements of the DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars as alleged above.

51. Save for slight differences not apparent to the ordinary retail consumer, Menendez's proprietary cigars and the accused cigars cannot be distinguished. Attached hereto collectively as Exhibit M and incorporated herein by reference are true copies of Menendez's DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars and packaging side-by-side with Defendant's accused cigars and packaging for comparison.

52. The use of Menendez's trademarks and distinctive trade dress makes the overall commercial impression of the accused cigars confusingly similar to that of Menendez's proprietary cigars. The accused cigars are highly likely to confuse the public and are undoubtedly designed for that exact purpose. Simply comparing Menendez's proprietary cigars with the accused cigars, it is difficult to distinguish between them.

53. Both the accused cigars and Menendez's proprietary cigars are marketed and directed at cigar aficionados and cigar smokers, and are sold to the public through the same retailers and channels of trade.

54. Defendant has also intentionally infringed on Menendez's intellectual property rights of by attempting to register "DONA FLOR," "ALONSO MENENDEZ," "DONA FLOR ALONSO MENENDEZ SERIES," and "DONA FLOR SELEÇÃO" with the USPTO under Defendant's name. Attached hereto collectively as Exhibit N and incorporated herein by reference are true copies of the online status reports from the USPTO Trademarks Applications and Registrations Retrieval ("TARR") system, showing Defendant BCT's attempted registrations of the above Menendez trademarks under Defendant's own name. Further, it is well established that continued use of a trademark by a terminated licensee, as is the case here, constitutes infringement.



55. On information and belief, Defendant sent out letters containing false information and signed by Dana Sheldon, Defendant's managing member, to various cigar retailers in a willful attempt to confuse them as to the source of Menendez's DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars. The letters stated, "Please be aware that as of 2007, Menendez Amerino, our previous manufacturer in Brazil, has been acquired by another company as a result of high demand and great ratings BCT has obtained on these cigars in the U.S. market. If you have received any letters or correspondence from Brazil, Menendez Amerino, Mitka or other companies defaming or disparaging our company or stating that BCT does not represent Menendez Amerino & Cia. Ltda., please disregard their notice as we are the only authorized U.S.A. distributor and owner of the U.S. trademarks for our products and the rightful owners/suppliers of the products in the U.S." This astonishing mendacity is evidence of Defendant's intentional infringement and improper intent.

56. On information and belief, following Menendez's termination of Defendant as its U.S. distributor, Defendant (a) specifically requested a third party manufacturer to produce counterfeits of Menendez's DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars; (b) placed infringing labels on the cigars after receiving them from the third party manufacturer; and (c) intentionally sold and offered the accused cigars for sale in knowing, willful and reckless disregard of Menendez's intellectual property rights.

57. Even if Defendant had merely purchased the infringing cigars already fully designed and manufactured, and being otherwise offered for sale to the general public, Defendant would still be liable for contributory and vicarious infringement liability on part of Defendant, their officers, directors, and shareholders, under *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259, 264 (9th Cir. 1996) and related cases.

58. On information and belief, Defendant uses the DONA FLOR™ name in connection with a domain name and website located at <[www.donaflorcigar.com](http://www.donaflorcigar.com)>.

59. Defendant intentionally infringes the trade dress and logo of the DONA FLOR™ mark on its website, <www.donaflorcigar.com>. Attached hereto collectively as Exhibit O and incorporated herein by reference are true copies of print-outs of Defendant's website pages.

60. Menendez has not authorized Defendant's infringing behavior.

**FIRST CLAIM FOR RELIEF**

**False Designation of Origin and Trade Dress Infringement [15 U.S.C. § 1125(a)]**

61. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

62. Defendant's actions of designing or having designed, manufacturing or having manufactured, selling, and/or distributing the accused cigars in commerce, without Menendez's consent, is a false designation of origin and trade dress infringement, and has caused and continues to cause a likelihood of confusion, mistake, and deception as to source, sponsorship, affiliation, and/or connection in the minds of the public.

63. Defendant's false designation of origin and trade dress infringement in commerce has infringed Menendez's trademark rights in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1).

64. By reason of the foregoing, Menendez has been injured in an amount not yet fully determined, but believed to be in excess of \$75,000. In addition, as a result of Defendant's acts of infringement, Menendez has suffered and will continue to suffer irreparable harm, and Menendez has no adequate remedy at law with respect to this injury. Unless Defendant's acts of infringement are further enjoined by this Court, Menendez will continue to suffer a risk of irreparable harm.

65. Defendant's actions have been knowing, intentional, wanton, and willful, entitling Menendez to damages, treble damages, profits, attorney's fees, and the costs of this action pursuant to 15 U.S.C. § 1117 in this Court's discretion.

**SECOND CLAIM FOR RELIEF**

**Trademark Infringement of Menendez's DONA FLOR™, ALONSO MENENDEZ™, and  
AQUARIUS™ Trademarks [15 U.S.C. § 1125(a)]**

66. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

67. This claim is for trademark infringement under the laws of the United States, Section 32 of the Lanham Act, 15 U.S.C. § 1125(a).

68. Defendant has reproduced, counterfeited, copied, advertised, distributed, and offered for sale, infringements of Menendez's proprietary DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars, infringing Menendez's trademarks.

69. Specifically, Defendant has reproduced, counterfeited, copied, and offered for distribution, and advertising, counterfeit cigars designed identically to the DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars, and prominently featuring the marks "DONA FLOR," "ALONSO MENENDEZ," "DONA FLOR ALONSO MENENDEZ SERIES" and "AQUARIUS" on the packaging. The infringing cigars have been promoted and sold in the United States, including this judicial district.

70. Such actions constitute infringement of Menendez's trademark rights to the DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ trademarks, and such use by Defendant of the infringing marks is likely to cause confusion as to source among consumers of these products given the identical goods.

71. The prominent display of "DONA FLOR," "ALONSO MENENDEZ," "DONA FLOR ALONSO MENENDEZ SERIES" and "AQUARIUS" in connection with and on Defendant's counterfeit and infringing cigars is a blatant attempt to confuse the consuming public as to the source of Defendant's goods, and unfairly to trade off Menendez's earned goodwill and reputation in the cigar industry.

72. Defendant has acted knowingly and willfully, with full knowledge of the likelihood of confusion as to the sponsorship and/or confusion of Defendant's infringing cigars and with the intent to deceive consumers in order to trade off the promotional efforts and earned

goodwill and reputation of Menendez in cigar industry. Defendant has acted in utter and knowing disregard for Menendez's rights in the DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ trademarks.

73. Defendant was only ever authorized by contract to register the DONA FLOR™, ALONSO MENENDEZ™, AQUARIUS™, and related trademarks in Menendez's name and at Menendez's cost. Menendez never authorized the registration of the above and related marks under Defendant's name. Defendant has nevertheless intentionally and knowingly acted to do so with the knowledge and intent to cause confusion, mistake, or to deceive as to the source of its product.

74. When Defendant breached the contract, thereby terminating the contract, Defendant lost all rights to use Menendez's DONA FLOR™, ALONSO MENENDEZ™, AQUARIUS™, and related trademarks. Menendez has not authorized any subsequent use of the DONA FLOR™, ALONSO MENENDEZ™, AQUARIUS™, and related trademarks, nor any confusingly similar marks. Defendant has nevertheless knowingly undertaken such use and acted with the knowledge and intent to cause confusion, mistake, or to deceive as to the source of its product.

75. By reason of the foregoing acts of trademark infringement, Menendez has been monetarily injured in an amount not yet ascertained, but believed to be in excess of \$75,000.

76. In addition, as a result of the acts of trademark infringement, Menendez has suffered and will continue to suffer irreparable harm from the Defendant's manufacturing, importing, marketing, distribution, and sales of the infringing and counterfeit product. Menendez has no adequate remedy at law with respect to this injury. Unless the acts of trademark infringement are enjoined by this Court, Menendez will continue to suffer irreparable harm.

**THIRD CLAIM FOR RELIEF**

**Trademark Dilution of Menendez's DONA FLOR™, ALONSO MENENDEZ™, and  
AQUARIUS™ Trademarks [15 U.S.C. § 1125(c)]**

77. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

78. This claim is for trademark dilution under the laws of the United States, Section 43 of the Lanham Act, 15 U.S.C. § 1125(c).

79. Because of the substantial investment Menendez has made in marketing goods in connection with its DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ trademarks, years of continuous use in commerce, and extensive advertising and publicizing of its cigars, including providing promotional and marketing materials, interviewing with the media, sending representatives to participate in fairs and expositions, and providing samples of cigars and cigarillos, the DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ marks have become instantly recognizable and distinctive in the cigar industry, gained secondary meaning, and become both distinctive and famous. Thus, Menendez's marks qualify as "famous marks" under the Federal Trademark Dilution Act ("FTDA"), 15 U.S.C. § 1125(c).

80. Defendant's manufacturing, distribution, marketing, use, and sale of the counterfeit and infringing products using the marks or identifiers "DONA FLOR," "ALONSO MENENDEZ," "DONA FLOR ALONSO MENENDEZ SERIES" and "AQUARIUS," dilute the capacity of said marks to identify and distinguish Menendez's goods or services.

81. By reason of the foregoing acts of trademark dilution, Menendez has been monetarily injured in an amount not yet ascertained, but believed to be in excess of \$75,000.

82. Menendez has no adequate remedy at law with respect to this injury. Unless the acts of trademark dilution are enjoined by this Court, Menendez will continue to suffer irreparable harm.

**FOURTH CLAIM FOR RELIEF**  
**Cybersquatting [15 U.S.C. § 1125(d)]**

83. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

84. This claim is for cybersquatting under the laws of the United States, Section 43 of the Lanham Act, 15 U.S.C. § 1125(d).

85. Defendant's <www.donaflorcigar.com> domain name is confusingly similar to Menendez's DONA FLOR™ trademark. Defendant has registered, has used, and/or is using the <www.donaflorcigar.com> domain name with the bad faith intent to profit from Menendez's DONA FLOR™ mark, in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125(d).

86. By reason of the foregoing acts of cybersquatting, Menendez has been monetarily injured in an amount not yet ascertained, but believed to be in excess of \$75,000.

87. Menendez has no adequate remedy at law with respect to this injury. Unless the acts of cybersquatting are enjoined by this Court, Menendez will continue to suffer irreparable harm.

**FIFTH CLAIM FOR RELIEF**  
**Breach of Contract**

88. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

89. On March 11, 2005, after extensive negotiations, a Distribution Agreement ("Agreement") was executed between Plaintiff Menendez and Defendant BCT, which established Defendant as the distributor of certain Menendez products, mainly cigars and cigarillos, in the United States, Canada, and Thailand.

90. Menendez fully performed all covenants and conditions of the Agreement.

91. Pursuant to Clause 6 of the Agreement, Defendant was required to tender 50 percent of the full payment amount to Menendez upon placement of a purchase order, and the remaining 50 percent (thus, full payment) to Menendez within five business days after issuance

of the Bill of Lading, under penalty of a monthly fine and interest to be calculated on the full purchase value. Nevertheless, in the course of performance under the Agreement, Defendant consistently delayed payments for merchandise it had already received, in violation of the Agreement.

92. Pursuant to Clause 9.5 of the Agreement, Defendant was required to purchase an annual minimum volume of products. Nevertheless, Defendant failed to meet minimum order goals in the second and third years of the Agreement, in violation of the Agreement.

93. Pursuant to Clause 7.2.1 of the Agreement, Defendant was required to maintain the business structure reasonably necessary, including hiring sufficient personnel, in order to perform its duties under the Agreement. Nevertheless, Defendant unreasonably refused to adopt a proposal submitted by Menendez which aimed to improve Defendant's personnel structure to meet U.S. market demands, in violation of the Agreement.

94. Pursuant to Schedule 2 of the Agreement, Defendant was allowed to register Menendez's trademarks only if Defendant did so under Menendez's name at Menendez's cost, during the term of the Agreement. Nevertheless, Defendant attempted to register Menendez's trademarks under Defendant BCT's own name, in violation of the Agreement.

95. Defendant's actions enumerated above, separately and combined, constituted material breaches of the contract and effectively terminated the Agreement pursuant to Clause 11.1 of the Agreement. Menendez informed Defendant of the termination on January 7, 2008.

96. Pursuant to Clause 11.6 of the Agreement, as the "failing party" to the Agreement, Defendant was expressly prohibited for a period of five years from distributing Menendez's products and registering its trademarks, and any other actions relating to Menendez's products authorized by the Agreement. Nevertheless, Defendant has openly disregarded the termination of the Agreement, enlisted another factory in Brazil to manufacture counterfeit copies of Menendez's proprietary cigars, has continued to distribute counterfeits of Menendez's proprietary cigars, and has continued to prosecute its applications to wrongfully register Menendez's marks in Defendant's own name.

97. As a result of Defendant's breaches of the Agreement, Menendez has been monetarily injured in an amount not yet ascertained, but believed to be in excess of \$75,000.

98. In addition, Menendez has suffered and will continue to suffer irreparable harm if Defendant continues to manufacture, import, market, distribute, and sell of the infringing and counterfeit product, and if Defendant continues to attempt to register Menendez's trademarks and oppose Menendez's trademark applications. Menendez has no adequate remedy at law with respect to this injury. Unless Defendant's acts are enjoined by this Court, Menendez will continue to suffer irreparable harm.

### **SIXTH CLAIM FOR RELIEF**

#### **Defamation—Slander**

99. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

100. Dana Sheldon, a managing member of Defendant and representing Defendant, told *Cigar Insider* on behalf of Defendant that Menendez sent "very poor product[s]" to Defendant, and that Menendez's shipments "were not sellable." Attached hereto as Exhibit P and incorporated herein by reference is a true copy of print-outs of this article. These comments were published in the May 6, 2008 issue of *Cigar Insider*, and constitute false and unprivileged communications to third parties of purported facts that have directly injured Menendez with respect to Menendez's business, trade, and profession.

101. The above comments were made by Defendant, knowing that the statements were false, with the primary purpose of injuring Menendez's business.

102. *Cigar Insider* is a highly circulated publication among the cigar industry and among the customers that Menendez targets.

103. As a direct and proximate result of Defendant's conduct, Menendez has suffered damages, including the loss of current and future business, damage to its reputation and



goodwill, prejudgment interest, and consequential economic damages, including but not limited to attorney's fees.

**SEVENTH CLAIM FOR RELIEF**

**Defamation—Libel**

104. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

105. Dana Sheldon, a managing member of Defendant and representing Defendant, told *Cigar Insider* that Menendez sent BCT “very poor product[s]” and that Menendez’s shipments “were not sellable.” These comments and publications to a third party were made knowing that they would be published in *Cigar Insider*, and the comments and publications to a third party were in fact published in the May 6, 2008 issue of *Cigar Insider*, and constitute false and unprivileged communications of purported facts that have directly injured Menendez with respect to their business, trade, and profession.

106. The above comments were made by Defendant, knowing that the statements were false, with the primary purpose of injuring Menendez’s business.

107. *Cigar Insider* is a highly circulated publication among the cigar industry and among the customers that Menendez targets.

108. As a direct and proximate result of Defendant’s conduct, Menendez has suffered damages, including the loss of current and future business, damage to its reputation and goodwill, prejudgment interest, and consequential economic damages, including but not limited to attorney’s fees.

**EIGHTH CLAIM FOR RELIEF**

**Unfair Competition**

109. Menendez incorporates herein by reference each and every allegation in the preceding paragraphs.

110. Defendant's acts and conduct herein alleged constitute unlawful acts of unfair competition at common law and unlawful, unfair, and fraudulent business practices in violation of the Lanham Act, 15 U.S.C. §§ 1051 *et seq.* and Florida Statute § 501.204.

111. As a direct and proximate result of Defendant's conduct, Menendez has suffered damages, including the loss of current and future business, damage to its reputation and goodwill, prejudgment interest, and consequential economic damages, including but not limited to attorney's fees.

### **PRAYER FOR RELIEF**

WHEREFORE, Menendez prays the Court grant relief as follows:

1. Judgment in Menendez's favor on all claims herein;
2. A preliminary and permanent injunction preventing Defendant and those additional parties specified in Federal Rule of Civil Procedure 65(d) from continued infringement of Menendez's intellectual property rights in any manner, including common law trademark and trade dress for Menendez's DONA FLOR™, ALONSO MENENDEZ™, and AQUARIUS™ cigars, and any and continued false designation of origin and trade dress infringement;
3. Order that the Defendant withdraw its trademark applications for "DONA FLOR," "ALONSO MENENDEZ," "DONA FLOR ALONSO MENENDEZ SERIES," and "DONA FLOR SELECAO" from the USPTO;
4. An accounting of profits and damages resulting from Defendant's false designation of origin, trade dress infringement, trademark infringement, trademark dilution, counterfeiting, and cybersquatting, and trebling such damages under the trademark laws because of the knowing, intentional, and willful nature of Defendant's conduct;
5. An award to Menendez of (a) an amount equal to the actual damages suffered by Menendez as a result of the infringement of its proprietary trade dress; (b) an amount equal to the profits earned by Defendant as a result of its infringing creation, design, distribution, packaging, and sales, or as a result of Defendant's purchase and re-sale of its infringing product; (c) an

amount equal to three times the monetary award assessed in view of Defendant's willful and wanton infringement under 15 U.S.C. § 1117; (d) prejudgment interest and post-judgment interest; (e) an amount equal to Menendez's reasonable attorney's fees, on the basis that this action is an "exceptional" case under 15 U.S.C. § 1117;

6. Order that the <www.donaflorcigar.com> domain name be transferred to Menendez;

7. For the cybersquatting claim, enhanced damages pursuant to 15 U.S.C. § 1117(d), including but not limited to statutory damages up to \$100,000 for Defendant's violation of 15 U.S.C. § 1125(d);

8. An order for the seizure and forfeiture of all goods bearing counterfeit or infringing marks, and any and continued false designation of origin, upon delivery into the United States pursuant to 19 U.S.C. § 1526(e);

9. An award of interest, attorney's fees, and costs;

10. For defamation damages in an amount to be proved at trial, plus punitive damages for Defendant's false, published statement made primarily to harm Menendez;

11. For the breach of contract claim, damages to be proved at trial;

12. For the unfair competition claim, damages to be proved at trial; and

13. Such other and further relief as the Court deems proper.

Dated:

Respectfully submitted,

SHRAIBERG, FERRARA & LANDAU P.A.

By: 

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Attorneys for Plaintiff

MENENDEZ AMERINO & CIA LTDA

Dated: April 30, 2009

Respectfully submitted,

GORDON & REES LLP

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Attorneys for Plaintiff

MENENDEZ AMERINO & CIA LTDA

**REQUEST FOR JURY TRIAL**

Pursuant to Rule 38, Federal Rules of Civil Procedure, Menendez hereby demands its right to a jury trial on all issues triable to a jury.

Dated:

Respectfully submitted,

SHRAIBERG, FERRARA & LANDAU P.A.

By: 

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Dated: April 30, 2009

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MENENDEZ AMERINO & CIA LTDA

**UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF FLORIDA**

CASE NO. 09-21185-CIV-HOEVELER/GARBER

MENENDEZ AMERINO & CIA. LTDA,  
A Brazilian Corporation,

Plaintiff,

v.

BRAZIL CIGARS & TOBACCO LLC,  
A Delaware Corporation,

Defendant.

\_\_\_\_\_ /

**ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS**

Defendant, Brazil Cigars & Tobacco LLC (hereinafter “Brazil Cigars” or “Defendant”), by and through undersigned counsel, hereby Answers the Complaint, asserts its Affirmative Defenses, and Counterclaims as follows:

1. Brazil Cigars admits that this appears to be a case for alleged violation of Plaintiff’s purported intellectual property rights, breach of contract, and defamation, but denies liability. Brazil Cigars denies the remaining allegations of Paragraph 1 of the Complaint.

2. Brazil Cigars admits that at least portions of this action arise under the trademark laws of the United States, but denies any liability thereunder. Brazil Cigars also denies that all of the claims in this action arise under the trademark laws of the U.S.

3. Brazil Cigars admits that the Court would ordinarily have subject matter jurisdiction over the claims asserted in the Complaint. However, Brazil Cigars lacks sufficient information concerning whether this Court has subject matter jurisdiction over the claims in the Complaint and therefore denies the same. Specifically, Paragraph 13.1

of the Contract upon which Plaintiff is suing appears to be an arbitration clause. Plaintiff reserves the right to move for dismissal of the action for lack of subject matter jurisdiction upon further review of the contract and research on the same.

4. Subject to the denial in Paragraph 3 above, Brazil Cigars admits that venue is appropriate.

5. Brazil Cigars lacks sufficient knowledge of the allegations of Paragraph 5 of the Complaint and therefore denies the same.

6. Brazil Cigars lacks sufficient knowledge of the allegations of Paragraph 6 of the Complaint and therefore denies the same.

7. Brazil Cigars admits the allegations of Paragraph 7 of the Complaint, but denies that such have any bearing on liability.

8. Brazil Cigars admits that it is subject to personal jurisdiction in this District, but denies the remaining allegations of Paragraph 8 of the Complaint.

9. Brazil Cigars admits the allegations of Paragraph 9 of the Complaint.

10. Brazil Cigars denies the allegations of Paragraph 10 of the Complaint.

11. Brazil Cigars denies the allegations of Paragraph 11 of the Complaint.

12. Brazil Cigars admits that Dana Sheldon, the managing member of Brazil Cigars, sent Plaintiff an email on June 17, 2005, but denies that the allegations of Paragraph 12 of the Complaint conform to the language in Exhibit B to the Complaint. Brazil Cigars also lacks knowledge of allegations concerning “Menendez’s previous U.S. distributor” and therefore denies the same.

13. Brazil Cigars lacks knowledge of the allegations of Paragraph 13 of the Complaint and therefore denies the same. Furthermore, Brazil Cigars denies that the

allegations of Paragraph 13 of the Complaint conform to the language in Exhibit C to the Complaint.

14. Brazil Cigars admits that it sent Plaintiff a letter on November 16, 2007, but denies that the allegations of Paragraph 14 of the Complaint conform to the language in Exhibit D to the Complaint.

15. Brazil Cigars admits that the letter attached to the Complaint as Exhibit E appears to be a letter to Brazil Cigars and that the same appears dated January 7, 2008. However, Brazil Cigars denies the remaining allegations of Paragraph 15 of the Complaint.

16. Brazil Cigars admits that on January 21, 2008 it wrote to Plaintiff stating that it did not recognize the Plaintiff's unilateral termination of the contract. Brazil Cigars denies all remaining allegations of Paragraph 16 of the Complaint.

17. Brazil Cigars denies that the marks referred to in Paragraph 17 of the Complaint are "Menendez's marks" as alleged. Brazil Cigars admits that Plaintiff requested an extension of time to oppose registration of trademark applications filed by Brazil Cigars and that Plaintiff subsequently filed Opposition Proceeding Nos. 91184986 and 91184987 with the TTAB, but denies that Opposition Proceedings are suspended.

18. Brazil Cigars specifically denies that Plaintiff has any intellectual property rights in the United States as alleged in the Paragraph 18 of the Complaint. Brazil Cigars lacks information concerning the remaining allegations thereof and therefore denies the same.

19. Brazil Cigars lacks information concerning the allegations of Paragraph 19 of the Complaint and therefore denies the same.



20. Brazil Cigars denies that Plaintiff has “a strong reputation, loyal clientele, and goodwill in the market” as alleged in Paragraph 20 of the Complaint to the extent that the same applies to the United States cigar market. Brazil Cigars lacks information concerning the remaining allegations of Paragraph 20 of the Complaint and therefore denies the same.

21. Brazil Cigars denies the allegations of Paragraph 21 of the Complaint.

22. Brazil Cigars is without information concerning the allegations of Paragraph 22 of the Complaint and therefore denies the same.

23. Brazil Cigars admits that a book and movie named *Dona Flor e Seus Dois Maridos* were authored by Jorge Amado. However, Brazil Cigars denies the remaining allegations of Paragraph 23 of the Complaint.

24. Brazil Cigars admits that Exhibit H appears to be an article from Cigar Aficionado magazine, but denies the remaining allegations of Paragraph 24 of the Complaint. Furthermore, it was through Brazil Cigar’s efforts that “DONA FLOR” cigars have met with acclaim in the United States and through Brazil Cigar’s efforts that the article in question was featured in Cigar Aficionado.

25. Brazil Cigars admits that through its own efforts “DONA FLOR” brand cigars have received substantial acclaim, but denies that such acclaim is attributable to Plaintiff.

26. Brazil Cigars admits that “ALONSO MENENDEZ” brand cigars have been continuously sold in the United States since 2005, but denies that such is attributable to Plaintiff. Instead, such is attributable to Brazil Cigars. Brazil Cigars denies the remaining allegations of Paragraph 26 of the Complaint.

27. Brazil Cigars denies that Plaintiff has conducted any marketing effort in the United States, or that any goodwill associated with the “ALONSO MENENDEZ” mark is associated with or attributable to Plaintiff. Brazil Cigars lacks knowledge of the remaining allegations of Paragraph 27 of the Complaint and therefore denies the same.

28. Brazil Cigars admits that “DONA FLOR” brand cigars have received substantial acclaim, but denies that such acclaim is attributable to Plaintiff.

29. Brazil Cigars lacks knowledge of the allegations of Paragraph 29 of the Complaint and therefore denies the same.

30. Brazil Cigars lacks knowledge of the allegations of Paragraph 30 of the Complaint and therefore denies the same.

31. Brazil Cigars denies that the “DONA FLOR” and “ALONSO MENENDEZ” cigars offered in the United States were attributable to Plaintiff. Brazil Cigars lacks knowledge of the remaining allegations of Paragraph 31 of the Complaint and therefore denies the same.

32. Brazil Cigars lacks knowledge of the allegations of Paragraph 32 of the Complaint and therefore denies the same.

33. Brazil Cigars denies the allegations of Paragraph 33 of the Complaint.

34. Brazil Cigars denies the allegations of Paragraph 34 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

35. Brazil Cigars denies the allegations of Paragraph 35 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

36. Brazil Cigars denies the allegations of Paragraph 36 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

37. Brazil Cigars denies the allegations of Paragraph 37 of the Complaint.

38. Brazil Cigars denies the allegations of Paragraph 38 of the Complaint.

39. Brazil Cigars denies the allegations of Paragraph 39 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

40. Brazil Cigars denies the allegations of Paragraph 40 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

41. Brazil Cigars denies the allegations of Paragraph 41 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

42. Brazil Cigars denies the allegations of Paragraph 42 of the Complaint since Plaintiff does not have superior rights in the alleged trade dress as Brazil Cigars is the senior user.

43. Brazil Cigars denies the allegations of Paragraph 43 of the Complaint.

44. Brazil Cigars denies the allegations of Paragraph 44 of the Complaint.

45. Brazil Cigars denies the allegations of Paragraph 45 of the Complaint.

46. Brazil Cigars denies the allegations of Paragraph 46 of the Complaint.

47. Brazil Cigars denies the allegations of Paragraph 47 of the Complaint.

48. Brazil Cigars denies the allegations of Paragraph 48 of the Complaint.

49. Brazil Cigars denies the allegations of Paragraph 49 of the Complaint.

50. Brazil Cigars admits that many of the cigars offered by it include marketing material such as labels, which are similar to those used by Plaintiff, but denies that such establishes liability. Brazil Cigars is the senior and rightful user of the trademarks at issue in the United States.

51. Brazil Cigars admits that many of the cigars offered by it include marketing material such as labels, which are similar to those used by Plaintiff, but denies that such establishes liability. Brazil Cigars is the senior and rightful user of the trademarks at issue in the United States.

52. Brazil Cigars admits that there is a likelihood of confusion between certain of the cigars sold by Brazil Cigars and by Plaintiff, but denies that such establishes liability. Brazil Cigars is the senior and rightful user of the trademarks at issue in the United States.

53. Brazil Cigars lacks knowledge of the allegations of Paragraph 53 and therefore denies the same.

54. Brazil Cigars admits that it has filed trademark applications for “DONA FLOR,” “ALONSO MENENDEZ,” “DONA FLOR ALONSO MENENDEZ SERIES,” and “DONA FLOR SELECAO” but denies the remaining allegations of Paragraph 54 of the Complaint.

55. Brazil Cigars admits that it contacted its customers concerning Plaintiff’s breach of their contract, but denies the falsity of the statements made. Brazil Cigars denies the remaining allegations of Paragraph 55 of the Complaint.

56. Brazil Cigars denies the allegations of Paragraph 56 of the Complaint.

57. Brazil Cigars denies the allegations of Paragraph 57 of the Complaint.

58. Brazil Cigars admits the allegations of Paragraph 58 of the Complaint, but denies that such establish liability.

59. Brazil Cigars denies the allegations of Paragraph 59 of the Complaint.

60. Brazil Cigars denies that it has engaged in “infringing behavior” as alleged in Paragraph 60 of the Complaint. Brazil Cigars admits that its activities have not been authorized by Plaintiff, but denies that it requires any authorization therefrom.

#### **FIRST CLAIM FOR RELIEF**

61. Paragraph 61 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

62. Brazil Cigars denies the allegations of Paragraph 62 of the Complaint.

63. Brazil Cigars denies the allegations of Paragraph 63 of the Complaint.

64. Brazil Cigars denies the allegations of Paragraph 64 of the Complaint.

65. Brazil Cigars denies the allegations of Paragraph 65 of the Complaint.

#### **SECOND CLAIM FOR RELIEF**

66. Paragraph 66 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

67. Brazil admits that this appears to be a claim for trademark infringement.

68. Brazil Cigars denies the allegations of Paragraph 68 of the Complaint.

69. Brazil Cigars denies the allegations of Paragraph 69 of the Complaint.

70. Brazil Cigars denies the allegations of Paragraph 70 of the Complaint.

71. Brazil Cigars denies the allegations of Paragraph 71 of the Complaint.

72. Brazil Cigars denies the allegations of Paragraph 72 of the Complaint.

73. Brazil Cigars denies the allegations of Paragraph 73 of the Complaint. Brazil Cigars further alleges that it never required the “authorization” of Plaintiff to apply for registration of any trademark.

74. Brazil Cigars denies the allegations of Paragraph 74 of the Complaint.

75. Brazil Cigars denies the allegations of Paragraph 75 of the Complaint.

76. Brazil Cigars denies the allegations of Paragraph 76 of the Complaint.

### **THIRD CLAIM FOR RELIEF**

77. Paragraph 77 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

78. Brazil Cigars admits that this appears to be a claim for dilution.

79. Brazil Cigars denies the allegations of Paragraph 79 of the Complaint.

80. Brazil Cigars denies the allegations of Paragraph 80 of the Complaint.

81. Brazil Cigars denies the allegations of Paragraph 81 of the Complaint.

82. Brazil Cigars denies the allegations of Paragraph 82 of the Complaint.

### **FOURTH CLAIM FOR RELIEF**

83. Paragraph 83 of the Complaint does not admission or denial; to the extent it does, Brazil Cigars denies the same.

84. Brazil Cigars admits that this appears to be an action for cybersquatting.

85. Brazil Cigars denies the allegations of Paragraph 85 of the Complaint.

86. Brazil Cigars denies the allegations of Paragraph 86 of the Complaint.

87. Brazil Cigars denies the allegations of Paragraph 87 of the Complaint.

**FIFTH CLAIM FOR RELIEF**

88. Paragraph 88 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

89. Brazil Cigars admits that Plaintiff and Brazil Cigars entered into an agreement for the continued purchase and sale of cigars, but denies any implication that such establishes liability.

90. Brazil Cigars denies the allegations of Paragraph 90 of the Complaint.

91. Brazil Cigars denies that it “delayed payment” as alleged in Paragraph 91 of the Complaint, but admits that Paragraph 91 appears to recite certain terms of clause 6 of the agreement between the parties.

92. Brazil Cigars admits that clause 9.5 of the agreement between the parties required that Brazil Cigars purchase a certain minimum annual volume, but denies that it failed to meet this requirement.

93. Brazil Cigars denies the allegations of Paragraph 93 of the Complaint. Specifically, clause 7.2.1 of the agreement between the parties does not mention the word “personnel” nor was Brazil Cigars under any obligation to accept Plaintiff’s “proposals” for maintaining an “adequate organization” as set out in clause 7.2.1 of the agreement.

94. Brazil Cigars denies the allegations of Paragraph 94 of the Complaint. Schedule II does not mention, list, identify or name any trademarks.

95. Brazil Cigars admits that Plaintiff attempted to terminate the agreement between the parties on or about January 7, 2008, but denies the remaining allegations of Paragraph 95 of the Complaint.

96. Brazil Cigars denies the allegations of Paragraph 96 of the Complaint.

97. Brazil Cigars denies the allegations of Paragraph 97 of the Complaint.

98. Brazil Cigars denies the allegations of Paragraph 98 of the Complaint.

**SIXTH CLAIM FOR RELIEF**

99. Paragraph 99 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

100. Brazil Cigars admits that the statements alleged to have been made in Paragraph 100 were in fact made. However, Brazil Cigars denies the falsity of such statements.

101. Brazil Cigars denies the allegations of Paragraph 101 of the Complaint.

102. Brazil Cigars admits that *Cigar Insider* is a highly circulated publication among the cigar industry, but lacks information of the remaining allegations of Paragraph 102 of the Complaint and therefore denies the same.

103. Brazil Cigars denies the allegations of Paragraph 103 of the Complaint.

**SEVENTH CLAIM FOR RELIEF**

104. Paragraph 104 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

105. Brazil Cigars admits that the statements alleged to have been made in Paragraph 105 were in fact made. However, Brazil Cigars denies the falsity of such statements.

106. Brazil Cigars denies the allegations of Paragraph 106 of the Complaint.

107. Brazil Cigars admits that *Cigar Insider* is a highly circulated publication among the cigar industry, but lacks information of the remaining allegations of Paragraph 107 of the Complaint and therefore denies the same.



108. Brazil Cigars denies the allegations of Paragraph 108 of the Complaint.

**EIGHT CLAIM FOR RELIEF**

109. Paragraph 109 of the Complaint does not require admission or denial; to the extent it does, Brazil Cigars denies the same.

110. Brazil Cigars denies the allegations of Paragraph 110 of the Complaint.

111. Brazil Cigars denies the allegations of Paragraph 111 of the Complaint.

Brazil Cigars denies that Plaintiff is entitled to any of the relief sought in its WHEREFORE clause, including, but not limited to Paragraphs 1 through 13 of the same.

**AFFIRMATIVE DEFENSES**

1. Plaintiff failed to state a claim upon which relief may be granted.

2. Brazil Cigars is the senior user of the marks in dispute.

3. Even if Brazil Cigars is not the senior user of the alleged marks, Plaintiff is also not the senior user of the alleged marks. For example, at least two other parties namely, J.C. Newman Cigar Company and Manufactura de Tabacos S.A. have asserted superior rights to the disputed marks.

4. Plaintiff has made no *bona fide* use of the disputed marks in commerce in the United States.

5. Plaintiff has not made continuous use of the disputed marks in commerce in the United States.

6. Brazil Cigars has prior use of the disputed marks in commerce in the United States.

7. The contract between the parties for alleged distribution of Plaintiff's goods does not include any reference to any trademark for which Brazil Cigars is merely a distributor.

8. The contract between the parties for alleged distribution of Plaintiff's goods does not include any reference to any trademark for which Brazil Cigars may only seek trademark registration in the name of Plaintiff.

9. To the extent that Plaintiff has made any use of the disputed mark, such use is subsequent to Brazil Cigar's use.

10. Brazil Cigars is more than a mere distributor. Specifically:

- a. Brazil Cigars was the sole and exclusive distributor for the goods in the United States to the exclusion of Plaintiff;
- b. Brazil Cigars' name and contact information appear on packaging for the goods bearing the mark;
- c. Brazil Cigars exercised control over the nature and quality of the goods on which the mark appears;
- d. Customers looked to Brazil Cigars as standing behind the goods.
- e. Brazil Cigars received comments and complaints about the goods bearing the mark and made appropriate replacement and took other corrective actions.
- f. Brazil Cigars paid for advertising and promotion of the trademarked products in the United States.

11. Plaintiff is guilty of unclean hands.

12. Plaintiff materially breached the agreement between the parties before any alleged breach by Brazil Cigars.

13. The agreement between the parties is ambiguous and unenforceable.

14. The agreement between the parties constitutes a naked trademark license.

15. Brazil Cigars performed all of its obligations under the agreement between the parties.

16. Plaintiff has suffered no damages.

17. Plaintiff has no protectable intellectual property rights in the United States. For instance, the contract between the parties explicitly says that Plaintiff “declares that [it] does not have any corresponding or enforceable Intellectual Property Rights over the Products in the Territories. The [Plaintiff’s] Intellectual Property Rights over the Products subsists only in Brazil or in other territories other than [the United States, Canada, and Thailand].”

18. Plaintiff’s alleged trade dress is merely functional.

19. Plaintiff’s alleged trade dress is merely ornamental.

20. Plaintiff’s alleged trade dress has not acquired secondary meaning/distinctiveness.

21. Plaintiff’s alleged trade dress lacks distinctiveness.

22. Plaintiff’s alleged trade dress is not unique and is the subject of extensive third party use.

23. Plaintiff is not the senior user of its alleged trade dress.

24. Plaintiff has no registrations for any of the alleged intellectual property rights (whether trademarks or trade dress) upon which it is suing.

### **COUNTERCLAIMS**

Defendant, Brazil Cigars & Tobacco LLC (hereinafter “Brazil Cigars”), by and through undersigned counsel, hereby counterclaims against Plaintiff, Menendez Amerino & CIA LTDA (hereinafter “Menendez Amerino”) as follows:

1. Brazil Cigars is a Delaware limited liability company with a principal place of business in Miami-Dade County Florida.
2. Menendez Amerino is a Brazilian entity and has submitted itself to the personal jurisdiction of this Court by filing the instant proceeding.
3. The Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§1331 and 1338(a), and has supplemental jurisdiction over Brazil Cigar’s state law claims pursuant to 28 U.S.C. §1367(a).

### **COUNT I** (Breach of Contract)

4. Brazil Cigars incorporates by reference Paragraphs 1 through 3 of the counterclaims as though set out herein.
5. On or about March 11, 2005, the parties entered into an agreement for the continued purchase and sale of cigars. Specifically, Brazil Cigars was to purchase cigars from Menendez Amerino and would have exclusive rights to sell cigars produced by Menendez Amerino in the United States, Canada, and Thailand.
6. On information and belief, after March 11, 2005 and before the parties ceased doing business with one another, Menendez Amerino was selling cigars, in violation of the terms of the contract between the parties, to purchasers in the United States, Canada, and or Thailand.

7. The time and duration of the agreement between the parties “for a period of 05 (five) years with automatic renewal for periods of 05 (five) years on [Brazil Cigar’s] exclusive discretion and conditioned to the full completion of [Brazil Cigar’s] performance obligations pursuant to Clause 9” of the agreement.

8. Clause 9 of the agreement imposes certain minimum order requirements on Brazil Cigars, and no other requirements.

9. At all times material, Brazil Cigars met its obligations under the contract.

10. At all times material, Brazil Cigars met its obligations under clause 9 of the contract.

11. In or about late 2007 Menendez Amerino began unilaterally demanding extra-contractual obligations by demanding unreasonable amounts of control over Brazil Cigar’s operations and began demanding that Brazil Cigars adopt a “proposal” for the management of Brazil Cigar’s business.

12. Menendez Amerino falsely justified its “proposal” for the management of Brazil Cigar’s business claiming that it was entitled to do so under clause 7.2.1(h) of the agreement between the parties.

13. Clause 7.2.1(h) merely states that “[Brazil Cigars] shall set up and maintain an adequate organizational structure for sale, with all means and personnel as are reasonably necessary in order to ensure the fulfillment of its obligations under this contract for all Products and throughout the territories.” Nowhere in Clause 7.2.1(h) is there any indication that Menendez Amerino may impose any proposed structure for the management of Brazil Cigar’s operations.

14. Furthermore, given that Brazil Cigars at all times complied with its obligations under Clause 9 of the agreement, Brazil Cigars, by extension, was in compliance with Clause 7.2.1(h).

15. Furthermore, Menendez Amerino regularly sent Brazil Cigars substandard product that was not fit for sale to consumers.

16. On or about January 7, 2008 Menendez Amerino sent Brazil Cigars unilateral notification of its intention to terminate, and thereby breach, the contract between the parties.

**COUNT II**  
(Trade libel)

17. Brazil Cigars incorporates by reference Paragraphs 1 through 3 of the counterclaims as though set out herein.

18. Brazil Cigars has been continuously and exclusively selling “DONA FLOR” and “ALONSO MENENDEZ” brand cigars in the United States since at least 2005.

19. Through its long, exclusive, and continuous use of the “DONA FLOR” and “ALONSO MENENDEZ” marks in United States commerce, Brazil Cigars has acquired substantial goodwill in these trademarks.

20. In or about 2008 Menendez Amerino began making false statements to consumers of Brazil Cigar’s “DONA FLOR” and “ALONSO MENENDEZ” goods. Specifically, upon information and belief, Menendez Amerino sent letters to all or many of Brazil Cigar’s customers falsely claiming that Brazil Cigars is not the rightful owner of the “DONA FLOR” and “ALONSO MENENDEZ” trademarks in the United States and that Brazil Cigars’ “DONA FLOR” and “ALONSO MENENDEZ” are not genuine.

21. In or about August of 2008, representatives of Menendez Amerino attended the International Premium Cigar & Pipe Retailers Association tradeshow in Las Vegas, the premier tobacco trade show in the nation, and made false and damaging statements about Brazil Cigars to Brazil Cigars customers and potential customers. Specifically, upon information and belief, Menendez Amerino told attendees at the tradeshow that Brazil Cigars is not the rightful owner of the “DONA FLOR” and “ALONSO MENENDEZ” trademarks in the United States and that Brazil Cigars’ “DONA FLOR” and “ALONSO MENENDEZ” are not genuine.

22. These false statements have damaged Brazil Cigars reputation among consumers and customers, and has caused a substantial decline in Brazil Cigars’ sales since Menendez Amerino began making its false statements.

23. Menendez Amerino’s false statements have caused Brazil Cigars to irreparable harm.

24. Absent Court intervention, Menendez Amerino’s tortious acts will continue to cause Brazil Cigars immeasurable and irreparable harm.

25. Menendez Amerino’s false statements have caused Brazil Cigars to special damages.

**COUNT III**  
(Unfair Competition under the Lanham Act)

26. Brazil Cigars incorporates by reference Paragraphs 1 through 3 of the counterclaims as though set out herein.

27. Brazil Cigars has been continuously selling “DONA FLOR” and “ALONSO MENENDEZ” brand cigars in the United States since at least 2005.

28. Through its long and continuous use of the “DONA FLOR” and “ALONSO MENENDEZ” marks in United States commerce, Brazil Cigars has acquired substantial goodwill in these trademarks.

29. Brazil Cigars is the senior user of the “DONA FLOR” and “ALONSO MENENDEZ” marks in the United States and has common law rights thereto.

30. Subsequent to Brazil Cigars’ adoption and use of the “DONA FLOR” and “ALONSO MENENDEZ” marks in the United States, Menendez Amerino began marketing and selling “DONA FLOR” and “ALONSO MENENDEZ” brand cigars in the United States in competition with Brazil Cigars.

31. Menendez Amerino’s sale of “DONA FLOR” and “ALONSO MENENDEZ” cigars in the United States is likely to cause confusion among consumers, mistake or to deceive as to the source sponsorship or affiliation of Brazil Cigars’ and or Menendez Amerino’s products.

32. Menendez Amerino’s above actions have caused and will continue to cause Brazil Cigars irreparable harm.

**COUNT IV**  
(Florida Unfair Competition)

33. Brazil Cigars incorporates by reference Paragraphs 1 through 3 of the counterclaims as though set out herein.

34. Brazil Cigars has been continuously selling “DONA FLOR” and “ALONSO MENENDEZ” brand cigars in the United States since at least 2005.

35. Through its long and continuous use of the “DONA FLOR” and “ALONSO MENENDEZ” marks in United States commerce, Brazil Cigars has acquired substantial goodwill in these trademarks.



36. Brazil Cigars is the senior user of the “DONA FLOR” and “ALONSO MENENDEZ” marks in the United States and has common law rights thereto.

37. Subsequent to Brazil Cigars’ adoption and use of the “DONA FLOR” and “ALONSO MENENDEZ” marks in the United States, Menendez Amerino began marketing and selling “DONA FLOR” and “ALONSO MENENDEZ” brand cigars in the United States in competition with Brazil Cigars.

38. Menendez Amerino’s sale of “DONA FLOR” and “ALONSO MENENDEZ” cigars in the United States is likely to cause confusion among consumers, mistake or to deceive as to the source sponsorship or affiliation of Brazil Cigars’ and or Menendez Amerino’s products.

39. Menendez Amerino’s above actions have caused and will continue to cause Brazil Cigars irreparable harm.

WHEREFORE, Brazil Cigars respectfully requests:

- (a) A preliminary injunction, enjoining and restraining Menendez Amerino, and all those acting on its behalf, from the present use of, or further use or purchase of “DONA FLOR” and “ALONSO MENENDEZ” or any other of Brazil Cigars’ trademarks;
- (b) A permanent injunction, enjoining and restraining Menendez Amerino, and all those acting on its behalf, from the present use of, or further use or purchase of “DONA FLOR” and “ALONSO MENENDEZ” or any other of Brazil Cigars’ trademarks;
- (c) An Order mandating that Menendez Amerino be required to immediately account for and pay over to Brazil Cigars, all gains and profits acquired by

Menendez Amerino by reason of its use of enjoining and restraining Menendez Amerino, and all those acting on its behalf, from the present use of, or further use or purchase of “DONA FLOR” and “ALONSO MENENDEZ” or any other of Brazil Cigars’ trademarks;

- (d) An Order awarding Plaintiff all damages suffered as a result of Menendez Amerino’s illegal activities;
- (f) An Order awarding Brazil Cigars its attorneys’ fees and costs associated with this action;
- (h) An Order requiring that Menendez Amerino surrender to Brazil Cigars and/or destroy all infringing products and promotional material bearing the “DONA FLOR” and “ALONSO MENENDEZ” marks or any other of Brazil Cigars’ trademarks; and
- (i) An Order awarding such other and further relief as this court deems just and proper.

**JURY DEMAND**

Brazil Cigars demands a trial by jury on all issues so triable.

Dated: June 8, 2009

Respectfully submitted,

By: s/GUSTAVO SARDIÑA  
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**Attorneys for Defendant**

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that that the foregoing is being served this 8th day of June,  
2009 upon:

Bradley S. Shraiberg, Esq.  
SHRAIBERG, FERRARA, & LANDAU P.A.  
2385 NW Executive Center Drive, Suite 300  
Boca Raton, Florida 33431

And

Richard P. Sybert, Esq.  
GORDON & REES LLP  
101 W. Broadway, Suite 1600  
San Diego, California 92101

via U.S. Mail after filing the same with the Court's CM/ECF electronic filing system.

By: s/GUSTAVO SARDIÑA  
Gustavo Sardiña